

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MF

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/985,122 12/04/97 ANDERSSON

H ANDERSON-1-1

KENYON & KENYON
1500 K STREET, N.W.
SUITE 700
WASHINGTON DC 20005

WM01/0604

EXAMINER

HOOSAIN, A	
ART UNIT	PAPER NUMBER

2645

DATE MAILED:

06/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/985,122

Applicant(s)
Andersson et al.

Examiner
Allan Hoosain

Art Unit
2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on RCE, Preamendment D and IDS, 4/12/01

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 18-44 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 18-44 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 20 20) ☐ Other:

Art Unit: 2645

DETAILED ACTION

Allowable Subject Matter

1. Applicant is advised that the Notice of Allowance mailed 2/13/01 is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a Deposit Account.

2. The indicated allowability of the claims is withdrawn because upon further review of the prior art of record, Examiner believes that there is strong evidence to show obviousness and motivation for sending notification messages to both wireless and wireline communication devices. Rejections of the previously allowed claims and newly added claims based on the previously cited reference(s) follow.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 2645

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 18-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pepe et al.** (US 5,742,905) in view of **Seazholtz et al.** (US 5,333,173).

As to Claim 18, with respect to Figure 21, **Pepe** teaches a PCS system for providing voice messaging to stations connected to different communication networks comprising:

a voice mailbox; (Col. 5, lines 59-62)

a wireless network, 39, (mobile switching center interface) capable of receiving requests to leave messages in the voice mailbox for the PDA (wireless device) or the telephone (landline communication device); (Col. 5, lines 54-62, Col. 6, lines 1-3 and Figure 1); and

Art Unit: 2645

an application server (message waiting indicator) coupled to said mobile switching center interface (Figure 5, Label 114 and Col. 10, lines 55-65),

wherein when a request to leave a message is received at the mobile switching center interface for either the wireless device or the landline communication device, a notification message (message waiting indication) is transmitted to the wireless device and the landline communication device (Col. 6, lines 11-16).

Pepe does not teach the following limitations:

“a message waiting indication is transmitted to both the wireless device and the landline communication device”

However, **Pepe** teaches that notifications could be re-routed to alternate devices and, thereby, suggests sending notification messages to both a landline telephone and a mobile telephone (Col. 6, lines 13-16 and Col. 1, lines 36-38). **Seazholtz** teaches simultaneous notifications for personal check-up calls (Col. 2, lines 4-24). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add simultaneous calling capabilities to **Pepe's** invention for simultaneously calling wireline and wireless devices as taught by **Seazholtz's** invention in order to allow users to communicate from anywhere to anywhere at anytime.

As to Claims 19,25,30,35, 41, **Pepe** teaches the system of claim 18, wherein the application processor (message waiting indicator) is provided to said landline communication device through

Art Unit: 2645

a hub end office without passing through said mobile switching center (Figure 4 labels 50, 52 and Figure 5, label 58).

As to Claim 24, with respect to Figure 21, **Pepe** teaches a system for providing messaging to a plurality of stations, comprising:

a mailbox that is associated with a PDA (wireless device) and a phone (landline communication device) (Col. 6, lines 1-3 and Figure 21, label 44);

a mobile network interface, 48, coupled to a first mobile switching center, 39, serving said PDA (wireless device) (Figure 21);

said mobile network interface receiving a request through said mobile switching center to leave a message for a landline communication device (Col. 5, lines 54-59, Col. 6, lines 1-3 and Col. 25, lines 52-55, 65-67); and

PCI server (a message waiting indicator) coupled to said mobile network interface (Col. 25, lines 64-65),

wherein the PCI server (message waiting indicator) transmits a notification (message waiting indication) to the wireless device or the landline communication device when a request to leave a message is received for either the wireless device or the landline communication device (Col. 25, lines 30-39).

Pepe does not teach the following limitation:

“both the wireless device and the landline communication device when a request to

Art Unit: 2645

leave a message is received for either the wireless device or the landline communication device”

However, **Pepe** teaches that notifications could be re-routed to alternate devices and, thereby, suggests sending notification messages to both a landline telephone and a mobile telephone (Col. 6, lines 13-16 and Col. 1, lines 36-38). **Seazholtz** teaches simultaneous notifications for personal check-up calls (Col. 2, lines 4-24). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add simultaneous calling capabilities to **Pepe's** invention for simultaneously calling wireline and wireless devices as taught by **Seazholtz's** invention in order to allow users to communicate from anywhere to anywhere at anytime.

As to Claim 29, with respect to Figure 21, **Pepe** teaches a method comprising:

receiving a message for a wireless device and for a landline communication device through a mobile switching station (Col. 25, lines 30-39);

storing said message for said wireless device and said landline communication device in a destination address (telecommunication mailbox) (Col. 25, lines 65-67),

wherein said destination address (telecommunication mailbox) is associated with said wireless device and said landline communication device (Col. 25, lines 65-67); and

Pepe does not teach the following limitation:

“transmitting a message waiting indication to said wireless device and said landline

Art Unit: 2645

communication device”

However, **Pepe** teaches that notifications could be re-routed to alternate devices and, thereby, suggests sending notification messages to both a landline telephone and a mobile telephone (Col. 6, lines 13-16 and Col. 1, lines 36-38). **Seazholtz** teaches simultaneous notifications for personal check-up calls (Col. 2, lines 4-24). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add simultaneous calling capabilities to **Pepe's** invention for simultaneously calling wireline and wireless devices as taught by **Seazholtz's** invention in order to allow users to communicate from anywhere to anywhere at anytime.

As to Claim 34, with respect to Figures 5 and 21, **Pepe** teaches an apparatus comprising:

a PCI server (means) for receiving a message for a wireless device and for a landline communication device through a mobile switching station (Figure 21 and Col. 25, lines 52-55);

a sending capability (means) for storing said message for said wireless device and said landline communication device in a destination address (telecommunication mailbox) (Col. 25, lines 65-67),

wherein said destination address (telecommunication mailbox) is associated with said wireless device and said landline communication device (Col. 25, lines 65-67);

Pepe does not teach the following limitation:

Art Unit: 2645

“a means for transmitting a message waiting indication to said wireless device and said landline communication device”

However, **Pepe** teaches that notifications could be re-routed to alternate devices and, thereby, suggests sending notification messages to both a landline telephone and a mobile telephone (Col. 6, lines 13-16 and Col. 1, lines 36-38). **Seazholtz** teaches simultaneous notifications for personal check-up calls (Col. 2, lines 4-24). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add simultaneous calling capabilities to **Pepe's** invention for simultaneously calling wireline and wireless devices as taught by **Seazholtz's** invention in order to allow users to communicate from anywhere to anywhere at anytime.

As to Claim 40, with respect to Figure 5, **Pepe** teaches a system comprising:

a mailbox that is associated with a first communication device and a second communication device (Col. 5, lines 59-62);

a network interface to receive a request to leave a message (Col. 7, lines 22-24); and

a message waiting indicator coupled to said network interface (Col. 10, lines 55-65),

Pepe does not teach the following limitation:

“wherein the message waiting indicator transmits a message waiting indication to both the first communication device and the second communication device when a request to leave a message is received at the network interface”

Art Unit: 2645

However, **Pepe** teaches that notifications could be re-routed to alternate devices and, thereby, suggests sending notification messages to both a landline telephone and a mobile telephone (Col. 6, lines 13-16 and Col. 1, lines 36-38). **Seazholtz** teaches simultaneous notifications for personal check-up calls (Col. 2, lines 4-24). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add simultaneous calling capabilities to **Pepe's** invention for simultaneously calling wireline and wireless devices as taught by **Seazholtz's** invention in order to allow users to communicate from anywhere to anywhere at anytime.

As to Claims 20, 26, 31, 36 and 42, **Pepe** teaches the system of claim 19, wherein the message waiting indication is sent to said hub end office, and the message waiting indication is sent from said hub end office to the landline communication device through a remote end office over the Signaling System 7 network (Figure 4 and Col. 11, lines 3-5).

Pepe does not teach the following limitation:

“via an SMDI link”

Seazholtz teaches the limitation (Col. 8, lines 57-61). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add SMDI capability to **Pepe's** invention for carrying signaling information as taught by **Seazholtz's** invention in order to provide connections to voice mail systems.

Art Unit: 2645

As to Claims 21, 27, 32, 37, 43, **Pepe** teaches the system of claim 19.

Pepe does not teach the following limitation:

“wherein the message waiting indication is provided to the landline communication device using a simplified message desk data link”

Seazholtz teaches the limitation (Col. 8, lines 57-61). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add SMDI capability to **Pepe**'s invention for carrying signaling information as taught by **Seazholtz**'s invention in order to provide connections to voice mail systems.

As to Claims 22, 28, 33, 38, 44 **Pepe** teaches the system of claim 21:

Pepe does not teach the following limitation:

“wherein said message waiting indicator causes notifications to be sent to said wireless device and said landline communication device substantially simultaneously”

Seazholtz teaches simultaneous notifications for personal check-up calls (Col. 2, lines 4-24). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add simultaneous calling capabilities to **Pepe**'s invention for simultaneously calling wireline and wireless devices as taught by **Seazholtz**'s invention in order to allow users to communicate from anywhere to anywhere at anytime.

Art Unit: 2645

As to Claim 23, **Pepe** teaches the system of claim 21 wherein said message waiting indicator causes a notification to be first sent to a PDA (one of said wireless device and said landline communication device) and then subsequently causes a notification to be sent to the other one of said wireless device and said landline communication device when the PDA is not turned on (a predetermined condition is satisfied) (Col. 6, lines 13-16).

Response to Arguments

5. Applicant's arguments with respect to claims 18-44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bartholomew et al. (US 6,215,858) teach a voice mail system with SMDI signaling capability.

Picard et al. (US 6,233,318) teach integration of different message notification systems.

Pershan (US 5,260,986) teaches simultaneous calling of telephones and pagers.

7. Any response to this action should be mailed to:

Art Unit: 2645

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications intended for entry)

Or:

(703) 308-6296 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

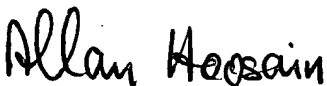
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Krista Zele**, can be reached on (703) 305-4701.

Application/Control Number: 08/985,122

Page 13

Art Unit: 2645

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Allan Hoosain
Primary Examiner
May 30, 2001